

REMARKS

Applicants respectfully request reconsideration of the present application.

CLAIMS STATUS

Pending claims include independent claim 38 and its dependent claims 33, 35, and 39-40.

Applicants thank the Examiner for withdrawing the finality of the Office Action dated November 28, 2007.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e)

Claims 33, 35, 38 and 40 stand rejected as anticipated by Zitzmann (U.S. patent 7,256,005). Applicants respectfully traverse.

The '005 patent is not a prior art reference against the pending claims because it was issued from a related application, which is a continuation in part of the present application, and the date that the PTO treats as the earliest effective filing date of the '005 patent is also the earliest effective filing date of the present claims.

The '005 patent was issued on August 14, 2007 from U.S. patent no. 10/669,175 filed September 23, 2003. The '175 application is a continuation in part of the present application 10/031,145, which was filed on January 17, 2002, as a National Phase entry of PCT/US00/21732 filed August 10, 2000. The '175 application claims priority to the following three U.S. provisional applications 1) no. 60/412,560 filed September 23, 2002; 2) no. 60/198,621 filed April 20, 2000; and 3) no. 60/148,101 filed August 10, 1999. Applicants submit the present application also claims priority to the '621 and '101 applications. Applicants further submit that the '175 application can be entitled to the filing dates of the '621 and '101 applications as its earliest effective filing date only through its relationship to the present application, so any common subject would necessarily have the same effective date..

In sum, because the '005 patent is not a prior art reference against the pending claims, Applicants request withdrawal of the rejection.

DOUBLE PATENTING REJECTION

Claims 33, 35, 38-40 stand rejected on the ground of non-statutory obviousness-type double patenting over claim 10 of U.S. patent no. 7,256,005. Applicants respectfully traverse.

Applicants respectfully submit that the one-way obviousness analysis used by the PTO in the double patenting rejection is an improper analysis under the current circumstances. Applicants respectfully submit that the PTO should have applied a two-way obviousness test instead of the one way analysis because the '005 patent was issued from an application that was filed later than the present application. See, the MPEP § 800.II.B.1(b):

“If the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed. A two-way test is to be applied only when the applicant could not have filed the claims in a single application *and* there is administrative delay. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998)”

Applicants submit that the present application satisfies both of the requirements for the two way obviousness test. As for the first requirement, Applicants submit that the claims of the '005 patent could not have been filed in the present application because the present application does not provide a written description support for the claims of the '005 patent. As for the second requirement, Applicants submit that an administrative delay in prosecution of the present application indeed did occur and not through the fault of the Applicants. In support, Applicants submit that the present application entered the US National phase on January 17, 2002, while the first Office Action on the merits, which was a Restriction Requirement, was mailed more than 41 months later on June 29, 2005. For comparison, U.S. application no. 10/669,175, from which the '005 patent was issued, was filed on September 23, 2003, and the first Office Action on the merits was mailed 21 months later on June 27, 2005.

Applicants submit that the two way obviousness analysis, which is necessary under the present circumstances for a proper double patenting rejection, requires establishment of the following two *prima facie* cases of obviousness: 1) a *prima facie* case of obviousness of the pending claims over the claims of the '005 patent; and 2) a *prima facie* case of obviousness of the claims of the '005 patent over the pending claims.

Applicants respectfully submit that the PTO at least failed to establish the second *prima facie* case of obviousness. Applicants respectfully submit the claims of the '005 patent are non-obvious over the pending claims because one of ordinary skill in the art could not have predictably arrived at the claims of the '005 patent, which recite a method of screening for an inhibitor of HCV p7 protein, from any of the pending claims of the present application.

In sum, Applicants respectfully request withdrawal of the rejection.

CONCLUSION

Applicants believe that the present application is in condition for allowance. Favorable reconsideration of the application is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,

otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date Jan. 9, 2009

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